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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/724,390 | 11/26/2003 | Luciano Hinojosa | 1043.1005 | 9665 |
| 7590 | 12/07/2004 | | EXAMINER | |
| Marguerite Del Valle, Esq. Trademark & Patent Counselors of America, P.C. 915 Broadway New York, NY 10010-7108 | | | ADDIE, RAYMOND W | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3671 | | |
| DATE MAILED: 12/07/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/724,390 | HINOJOSA, LUCIANO |
| Examiner | Art Unit | |
| Raymond W. Addie | 3671 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 July 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the phrase in line 1 "The safety protector is provided"; should be --A safety protector--, to remove redundant language. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In particular the phrase "for application on those safety rail barriers constituted by a stamped sheet attached on a metallic post with double 'T' or 'U' shape"; is being interpreted to require the protector to be capable of being

Further, the phrase "characterized in that it is constituted by an extruded profile with circular configuration, with an open section...on the vertical support post"; is being interpreted to require the protector to be generally "C-shaped" and capable of being made in an extrusion process; since the recited limitation in Claim 1 appears to be a Product-by-Process limitation in an apparatus type claim.

The phrase "said extruded profile being equipped with an internal sinuous configuration and with a series of stiffening ribs" is not illustrated in the figures, as claimed and disclosed, rather the illustrations only show the protector as having convex inner walls (4), an open end (2) and a closed end (at 5).

Therefore, the limitation is being interpreted to require an inner surface that is complementary to the shape of the post it is protecting.

The term "two parts of notable thickness" in claim 2 is a relative term which renders the claim indefinite. The term "notable thickness" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Hence, the limitation is seen to require two parts of a minimum thickness.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by roller.

Roller # 6,494,640 B2.

Roller discloses a column protector (10) that can be attached to an I-beam (12), in order to protect vehicles and drivers that may impact a post, pole or the like, such as a guard rail post. Said protector comprising:

A circular exterior configuration (52) that could be formed by extrusion.

An inner configuration complementary to the shape of the I-beam being protected.

A sinuous interior profile formed by stiffening ribs (54, 62); that further create energy damping air pockets (56).

An plurality of open sections (46, 40).

Wherein the protector further comprising 2 sections (14, 16), each having a wide portion disposed between 2 narrow sections. See figs. 2A, 4A. Said relatively wide sections being intended to be the primary impact face of the protector./

Further wherein the open section (40) corresponds to

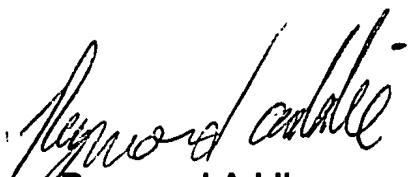
Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stamets Des. 380,274 discloses a column protector. Platt # 3,141,655 discloses an energy absorbing guard rail protector. Fitch # 3,643,924 discloses an energy absorbing guard rail assembly. Fitch # 6,010,275 discloses a compression guardrail. Mazza # 2,153,384 discloses a post protector intended to receive impacts from people, without causing damage to the protector or injury to the people. Barbazza # 5,915,876 discloses an impact absorbing plastic sheet. Glaesener # 3,963,218 discloses a vehicle guardrail with a metal core. McDonough # 1,101,307 discloses a post protector. Liddell # 3,372,552 discloses a pile fender. Darder-Alomar # 5,562,364 discloses a post fender. Vargo # 5,369,925 discloses a post protector.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2, 6-8.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raymond Addie
Patent Examiner
Group 3600